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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,261	08/01/2001	John Heinen	15-EC-6101 (070191-0312)	4040

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EXAMINER

THEIN, MARIA TERESA T

ART UNIT	PAPER NUMBER
3627	

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/920,261

Applicant(s)

HEINEN ET AL.

Examiner

Marissa Thein

Art Unit

3627



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 August 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on September 4, 2001 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                    |                                                                             |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____                                                |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>08-01-01</u>                                                              | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on August 1, 2001 is being considered by the examiner.

### ***Drawings***

The formal drawings filed on September 4, 2001 are acceptable.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 22-45 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 22-45 have no connection to the technological arts. None of the steps indicate any connection to a computer or technology. For instance claim 22, the steps of "viewing basic product information..."; "providing customer specification..."; "viewing a price quotation..."; and "accepting the price quotation....." could all be performed manually by a person. Therefore, the claim is directed towards non-statutory subject matter. The other claims above are similarly rejected. To overcome this rejection the Examiner recommends the Applicant amend the claims to better clarify which of the steps are being performed within the technological arts, such as "viewing on a computer interface basic product information for a plurality of capital products at a business-to-business exchange computer system".

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-45 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S.**

**Patent No. 6,141,653 to Conklin et al.**

Regarding claims 1 and 12, Conklin discloses a system for purchasing customized capital equipment (production purchasing includes components, subassemblies or parts) in an online marketplace environment, comprising: a business-to-business exchange web page (sponsored community addresses corporate buyers and sellers engaged in production purchasing; col. 17, lines 57-58; business to business negotiation, col. 18, lines 66-67) including basic product information for a plurality of capital equipment products (allows a buyer/participant to search and evaluate seller information; col. 14, lines 3-4); at least one link included in the exchange web page for punching through from the exchange web page to a product provider web page (each member of the community to install Webserver, application server and database server software at each sponsor site and at all or some participant sites in a community such as sponsored community; col. 18, lines 54-62 ); means for presenting a price quotation (alerts sellers and buyers that pending offer or counteroffer has been submitted, so that

Art Unit: 3627

they may return to the system to negotiate or resume negotiations, col. 19, lines 31-34); and an acceptance module configured for enabling acceptance of the price quotation at the exchange web page (a seller has accepted all the terms of an open buying agreement, col. 21, lines 7-12).

Regarding claims 2, 13, and 23, the recitations that "the capital equipment products include medical equipment", such recitation is given little patentable weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other "capital equipment" already disclosed by Conklin.

Regarding claims 3-11, 14-21, 30-32, 35-40, and 42-45, Conklin discloses wherein the price quotation is generated by a product provider (seller); product configurator (col. 8, lines 26-39; Figure 31b); unique customer requirements providing a customer specifications (a buyer proposes a negotiation of order terms, col. 20, lines 24-25; buyer's request for proposal or a request for a quote, col. 20, lines 27-30); wherein the product provider web page includes means for receiving customer requirements for the capital equipment product (Letter of Credit; Figures 15b; 15 C-1; 15 C-2); means for communicating the price quotation acceptance to a product provider (Figure 12); wherein the means for communicating includes means for triggering a price quotation acceptance at the product provider web page (Figure 16); wherein the means for communicating includes means for sending a notification to the product provider (Figure 20); a hyperlink to the product provider web page (Figures 31a); means for automatically eliciting purchaser requirements for use in generating the price quotation

Art Unit: 3627

(Letter of Credit; Figures 15b; 15 C-1; 15 C-2); and providing automatically generating a series of questions designed to elicit purchaser requirements and displaying the questions to a purchaser (Letter of Credit; Figures 15b; 15 C-1; 15 C-2).

Regarding claims 22, 29, 33-34 and 41, Conklin discloses a method for purchasing customized capital equipment product (production purchasing includes components, subassemblies or parts) in an electronic market place, comprising: viewing or displaying basic product information (allows a buyer/participant to search and evaluate seller information; col. 14, lines 3-4); providing at the exchange web page a link to a price quotation (each member of the community to install Webserver, applicant server and database server software at each sponsor site and at all or some participant sites in a community such as sponsored community, col. 18, lines 54-62) providing a customer specifications (a buyer proposes a negotiation of order terms, col. 20, lines 24-25; buyer's request for proposal or a request for a quote, col. 20, lines 27-30); viewing a price quotation (alerts sellers and buyers that pending offer or counteroffer has been submitted, so that they may return to the system to negotiate or resume negotiations, col. 19, lines 31-34); accepting the price quotation (a seller has accepted all the terms of an open buying agreement, col. 21, lines 7-12); and communicating the acceptance to a product provider (a seller has accepted all the terms of an open buying agreement, col. 21, lines 7-12; Figure 18).

Regarding claims 24-28, Conklin discloses viewing a business-to-business exchange web page using a web browser (Figure 14); punching through to a product provider web page (Figure 31a); answering a series of questions regarding customer

Art Unit: 3627

requirements (Letter or Credit; Figures 15b; 15 C-1; 15 C-2); at least a portion of the questions may be answered at the provider web page (Letter or Credit; Figures 15b; 15 C-1; 15 C-2); and viewing the price quotation takes place at the exchange web page (Figure 12; Figure 13).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,870,719 to Maritzen et al. disclose a quote configuration system comprising a client module for receiving quote input and command selection from a user, and a server coupled to the client module.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 703-305-5246. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 703-308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3627

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot

November 24, 2004

*Michael Cuff* 11/24/04  
MICHAEL CUFF  
PRIMARY EXAMINER